UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,576	03/08/2000	Roland Vincent St. John Killick	03628-0450	1427

29052	7590	07/21/2004

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EXAMINER
DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/520,576	ST. JOHN KILLICK, ROLAND VINCENT
	Examiner	Art Unit
	Arthur Duran	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 April 2004</u>.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>34-40,42,43,46,47 and 50-60</u> is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>34-40,42,43,46,47 and 50-60</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All   b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 34-40, 42, 43, 46, 47, and 50-60 have been examined.

Response to Amendment

2. The Amendment filed on 4/5/04 is sufficient to overcome the Stevens and "What Grocers

Want" reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 34-40, 42-43, 46, 47, 50-60 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stevens (6,327,570) in view of "What Grocers Want in Electronic Marketing

Programs" POS News, v.7, n.13, 5/91 and in view Barnett (6,321,208).

Stevens teaches a system for analyzing consumer data comprising: a computer program

for analyzing consumer data (col. 8, lines 5-15); a terminal device (col. 7, lines 35-55); and a

consumer data acquisition device that stores consumer data (col. 6, lines 1-15, col. 7, lines 25-

35); wherein the terminal device is operable to selectively extract at least a portion of the

consumer data stored on the consumer data device for analysis by the computer program (col. 19,

lines 1-40, col. 10, lines 35-45); the terminal device is operable to transmit consumer data to the

consumer device (col. 7, lines 35-60, col. 8, lines 50-65); the consumer data acquisition device

can at least be a barcode reader with memory, a digital computer, or a personal digital assistant

(col. 8, line 50 – col. 10, line 30); the terminal is positioned local to a point of sale terminal or a

network terminal (col. 7, lines 35-45, col. 17, lines 5-45, col. 18, lines 5-15); the program resides

in part at the consumer acquisition device (col. 10, lines 25-60) and a data collection center

operable to identify consumer data for analysis where the computer program resides at least in

part (col. 8, lines 1-35).

The article teaches selectively extracting consumer data for analysis and inferring

information from the database (p. 1-2). It would have been obvious to one having ordinary skill

in the art at the time of the invention to have selectively extracted information where the terminal

cannot extract all of the customer data and inferred marketing information as taught in the article

in the system of Stevens since this would have avoided the problems of gathering too much

information as described in the article. It also would have been obvious to have cleared at least a

portion of the consumer data from the consumer data device since this would have been adopted

for the intended use of freeing limited memory of the user card for continued use of the card. It

also would have been obvious to one having ordinary skill in the art to have modified the

consumer data since this would have been adopted for the intended use of receiving the most up

to date promotions as described in Stevens.

Barnett further discloses that said computer program is operable to analyze consumer

data, said analysis further comprising filtering said consumer data (col 12, lines 25-65).

Barnett further discloses that the output of said analysis is an inferred marketing database

(col 12, lines 25-65; Fig 10).

Barnett further discloses a computer program for analyzing computer data wherein said

computer program is at least in part remote from said terminal device (Fig. 1; Fig. 8; col 12, line

65-col 13, line 10; col 13, line 50-col 14, line 6); and

A collection center, in communication with the terminal device (Fig. 1; Fig. 8; col 12,

line 65-col 13, line 10; col 13, line 50-col 14, line 6), where the collection center instructs the

terminal device to extract all of the consumer data from the consumer data acquisition device

(col 5, lines 27-35; col 12, lines 30-36).

Barnett further discloses that different parts of consumer data can be utilized in analysis

(col 12, lines 37-50). Therefore, it would have been obvious to Barnett to extract the information

of interest.

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Barnett's variably distributed information providing and analysis

features to Stevens' analysis of consumer data. One would have been motivated to do this in

order to more expansive and flexible options for consumer analysis.

4.   Claims 34-40, 42, 43, 46, 47, 50-60 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gottlich (6,024,288) in view of "What Grocers Want in Electronic Marketing

Programs" POS News, v.7, n.13, 5/91 and in view Barnett (6,321,208).

Gottlich teaches a system for analyzing consumer data comprising: a computer program

for analyzing consumer data (col. 8, lines 45-60, col. 11, lines 35-65); a terminal device (PRW);

and a consumer data acquisition device that stores consumer data (user card, col. 11, lines 55-

65); wherein the terminal device is operable to selectively extract at least a portion of the

consumer data stored on the consumer data device for analysis by the computer program (col. 11, line 50 – col. 12, line 15, col. 12, line 50 – col. 13, line 15); the terminal device is operable to transmit consumer data to the consumer device (col. 8, lines 45-55); the consumer data acquisition device is a magnetic medium (col. 6, lines 60-65, col. 7, lines 10-15); the terminal is positioned local to a point of sale terminal or a network terminal (col. 11, lines 20-50); the terminal device modifies consumer data from a memory of consumer data acquisition device (col. 13, lines 5-15); the program resides in part at the terminal device (col. 12, lines 40-67, col. 14, lines 20-40) and a data collection center operable to identify consumer data for analysis where the computer program resides at least in part (col. 11, line 45- col. 12, line 15).

The article teaches selectively extracting consumer data for analysis and inferring information from the database (p. 1-2). It would have been obvious to one having ordinary skill in the art at the time of the invention to have selectively extracted information where the terminal cannot extract all of the customer data and inferred marketing information as taught in the article in the system of Gottlich since this would have avoided the problems of gathering too much information as described in the article. It also would have been obvious to have cleared at least a portion of the consumer data from the consumer data device since this would have been adopted for the intended use of freeing limited memory of the user card for continued use of the card similar to clearing the memory of the PRW of Gottlich (col. 11, lines 60-65, col. 13, lines 5-10).

Barnett further discloses that said computer program is operable to analyze consumer data, said analysis further comprising filtering said consumer data (col 12, lines 25-65).

Barnett further discloses that the output of said analysis is an inferred marketing database (col 12, lines 25-65; Fig 10).

Barnett further discloses a computer program for analyzing computer data wherein said computer program is at least in part remote from said terminal device (Fig. 1; Fig. 8; col 12, line 65-col 13, line 10; col 13, line 50-col 14, line 6); and

A collection center, in communication with the terminal device (Fig. 1; Fig. 8; col 12, line 65-col 13, line 10; col 13, line 50-col 14, line 6), where the collection center instructs the terminal device to extract all of the consumer data from the consumer data acquisition device (col 5, lines 27-35; col 12, lines 30-36).

Barnett further discloses that different parts of consumer data can be utilized in analysis (col 12, lines 37-50). Therefore, it would have been obvious to Barnett to extract the information of interest.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's variably distributed information providing and analysis features to Gottlich's analysis of consumer data. One would have been motivated to do this in order to more expansive and flexible options for consumer analysis.

Response to Arguments

5.   Applicant's arguments with respect to claims 34-40, 42, 43, 46, 47, and 50-60 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to the motivation to combine the references, please see the enhanced rejections above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.
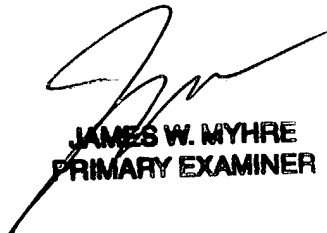
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/15/04

JAMES W. MYHRE
PRIMARY EXAMINER